

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Sana

Serial No.: 10/001,688

Filing Date: 10/25/2001

Examiner: Joyce Tung

Group Art Unit: 1637

Title: Composition and Methods for Optimized Hybridization Using Modified Solutions

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

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TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
(X) No additional fee (Address envelope to "Box Non-Fee Amendments") (fee \$ )  
( ) Other: \_\_\_\_\_

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$84	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$280	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$400.00	3RD MONTH \$920.00	4TH MONTH \$1440.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Sana

By

Bret Field

Attorney/Agent for Applicant(s)  
Reg. No. 37,620

Date: 10/11/2002

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: 10/11/2002

Typed Name: Martha Cisneros

Signature: 

Telephone No.: (650) 327-3400



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## CERTIFICATE OF MAILING

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Typed or Printed Name	MARITA OLIVEROS		
Signature		Date	10/11/02

<b>RESPONSE TO PAPER NO. 14</b>  Address to: Assistant Commissioner for Patents Washington, D.C. 20231	Attorney Docket Confirmation No.	10010819-1
	First Named Inventor	Sana
	Application Number	10/001,688
	Filing Date	October 25, 2001
	Group Art Unit	1637
	Examiner Name	Joyce Tung
	Title	Composition and Methods for Optimized Hybridization Using Modified Solutions

Dear Sir:

This communication is responsive to the office communication dated September 11, 2002 (i.e., Paper # 5).

In the above referenced office communication, the Examiner imposed a restriction requirement, requiring the election of the claims of either:

Group I, i.e., Claims 1-5 and 9-14; or  
Group II, i.e., Claims 6-8 and 15-17;

for further prosecution in this application.

The Applicants hereby elect Group II with traverse.

The Applicants also respectfully urge the Examiner to rejoin at least the kit claims of Group I (i.e., Claims 9-11) with the elected claims of Group II for examination in this application for the following reasons.

The MPEP allows an Examiner to examine otherwise patentably distinct sets of claims if to so would not impose an undue burden on the Examiner. M.P.E.P. § 8.03 states that:

**If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.**

In the present case, the kit claims are ones that are especially adapted for use in the claimed methods of elected Group II. As such, the search for the claims of Group II will find any prior art relating to the kit claims of Group I.

Accordingly, little, if any, additional searching should be required for the kit claims of Group I and therefore, the examination of the kit claims of Group I together with the claims of Group II should impose little, if any, additional burden on the Examiner.

As such, examining the claims of Group II and the kit claims of Group I together in the present application clearly does not impose an undue or serious burden on the Examiner. In the absence of such an undue or serious burden, the Examiner is clearly instructed by the MPEP to examine the entire application. Therefore, the Examiner is respectfully requested to rejoin the kit claims of Group I and with the claims of elected Group II and to examine all the claims together in the present application.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

BOZICEVIC, FIELD & FRANCIS LLP

Date: 10.11.02

By: 

Bret E. Field  
Registration No. 37,620

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